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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Eutectic Corporation

Serial No. 78350479

Mark J. Pandiscio of Pandiscio & Pandiscio, P.C. for
Eutectic Corporation.

Susan Kastriner Lawrence, Trademark Examining Attorney, Law
Office 116 (Meryl L. Hershkowitz, Managing Attorney).

Before Drost, Walsh and Cataldo, Administrative Trademark
Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Eutectic Corporation to
register the mark XUPERARC in standard character form on
the Principal Register for the following goods, as amended:
"electric welding machines for resistance welding,
incandescent welding, sparc welding and arc welding;
autogenous soldering machines; machines and machine tools
for the cutting and forming of materials; plasma etching
machines; cutting torches; and jets, tips and nose pipes

for use with plasma cutting torches" in International Class 7.¹

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as intended to be used on its goods, so resembles the mark, SUPERARC, previously registered on the Principal Register in standard character form, for "welding wire electrodes," in International Class 9² as to be likely to cause confusion.

When the refusal was made final, applicant appealed.³ Applicant and the examining attorney filed briefs and applicant filed a reply brief. Applicant requested an oral hearing; however, that request subsequently was withdrawn.

Applicant contends that it is the owner of Registration No. 1071690 for the mark XUPER for "metallic welding electrodes;" that the mark cited by the examining

¹ Application Serial No. 78350479 was filed January 12, 2004, based on applicant's assertion of its bona fide intent to use the mark in commerce. In response to a requirement by the trademark examining attorney, applicant claimed ownership of Registration No. 1071690.

² Registration No. 2460099, issued June 12, 2001. We note that at the time the cited registration was issued, a mark appearing in standard character form was identified as a "typed drawing."

³ In her first Office action, the trademark examining attorney also cited Registration No. 2709101, owned by the same registrant, as a bar to registration under Trademark Act Section 2(d). However, the examining attorney withdrew the refusal to register under Section 2(d) as to Registration No. 2709101 in her final Office action.

attorney in this case was registered subsequent to applicant's prior registration; that applicant's prior registration was not held to be confusingly similar to the mark cited as a bar to registration herein; and that, as a result, the mark in the cited registration should be afforded a narrow scope of protection. Applicant further contends that its XUPERARC mark differs from the cited SUPERARC mark in appearance, sound, and connotation; that "there are many registered marks that are phonetic equivalents of one another and used to identify similar goods;" (brief, page 10) and that in this case, "small differences in the marks and their use should be sufficient to distinguish them from one another." (brief, page 9) Applicant contends in addition that its goods differ significantly from those of registrant; that, specifically, its goods "are essentially completed machines, while registrant's goods are essentially components;" (brief, page 12) and that the differences between the goods is evidenced by their classification in different classes.

The examining attorney maintains that applicant's mark is nearly identical to the mark in the cited registration. Specifically, the examining attorney argues that applicant's XUPERARC mark differs from the mark, SUPERARC, in the cited registration only in the substitution of the

letter X" for the letter "S" as the first letter thereof; that the marks otherwise are identical in appearance and spelling; and that because both marks appear in standard character format, they may be presented in an identical fashion. The examining attorney further argues that the letters "X" and "S" are similar in pronunciation; that the marks thus are nearly identical in sound, connotation and commercial impression. The examining attorney contends in addition that evidence attached to her final Office action demonstrates that applicant's goods are commonly identified with those of registrant under the same mark; that applicant's own website indicates that it provides the goods identified in the cited registration as well as those in its subject application; that, as a result, "it may be presumed that purchasers are accustomed to seeing such goods with the same marks and are conditioned to believe they come from the same source;" (brief, unnumbered pages 9-10) and that consumers of such goods are further accustomed to purchasing them through the same trade channels. With regard to applicant's prior registration, the examining attorney contends that "the marks in the two registrations were much further apart along the spectrum of confusion - XUPER versus SUPERARC;" (brief, unnumbered page 12) that the mere "existence of two similar marks for

similar goods does not lead to a finding that a mark is weak;" (*Id.*) that in any event, even weak marks are entitled to protection against registration by a subsequent user of a confusingly similar mark for related goods or services; and that the actions and prior decisions of other examining attorneys are "without evidentiary value and are not binding upon the Office." (*Id.*)

Applicant argues in reply that the letter "X" is unique in the English language; that words beginning with the letter "X" are very uncommon; and that, as a result, "these words carry an air of sophistication and complexity in their sound;" (reply brief, page 3) that applicant's mark thus is "a powerful and commercially impressive term, and as such is easily distinguishable and memorable for consumers;" (*Id.*) and that the term "SUPER" in registrant's mark, by comparison, "carries a simpler, more descriptive meaning" and "creates a very different commercial impression in the mind of a consumer." (reply brief, pages 3-4) Applicant further argues that its mark is pronounced "ZUPERARC" which is different in both sound and meaning from registrant's SUPERARC mark.

Our determination of the issue of likelihood of

confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We begin by comparing the marks at issue, noting that the test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In this case, we note that applicant's mark, XUPERARC, and the registered mark, SUPERARC, both comprise eight letters, seven of which are identical and appear in

identical order. Thus, aside from the substitution of the letter "X" in applicant's mark for the letter "S" in that of registrant, the marks are identical in appearance. We further note that the marks both comprise "UPERARC" as their second through eighth letters, the only difference being the above-referenced substitution of the first letter thereof. Thus, the marks are nearly identical in spelling. In addition, we note applicant's assertion in its reply brief that its mark is pronounced "ZUPERARC." In that regard, there is no correct pronunciation of a trademark, and purchasers may pronounce the involved marks identically. Even if they do not, applicant's suggested pronunciation of its mark is very similar to the pronunciation of the cited mark. As a result, we are not persuaded by applicant's assertion that the presence of the letter "X" as the first letter of its mark lends the mark such an "air of sophistication and complexity in [its] sound" as to distinguish it from the mark in the cited registration. On the contrary, applicant's mark differs only with regard to a single letter that is very similar in sound to the corresponding letter in registrant's mark. Based upon the foregoing, we find that the marks are nearly identical in sound, appearance and spelling, and convey highly similar commercial impressions.

We turn now to comparing applicant's proposed goods with those of registrant. Applicant's goods, as noted above, include electric welding machines used for a variety of welding applications. Registrant's goods are "welding wire electrodes." Notably, applicant does not argue that its goods are unrelated to those of registrant, or that the goods otherwise would not be used together.⁴ Rather, applicant asserts that its goods are "completed machines" while those of registrant are components. We note, however, that applicant cites to no authority or evidence to support its apparent contention that welding components are unrelated to welding machines. In addition, the examining attorney submitted with her final Office action copies of use-based, third-party registrations covering both applicant's electric welding machines and welding electrodes. This evidence of record suggests that consumers will assume a common source upon encountering highly similar marks at least for electric welding machines and welding wire electrodes. Third-party registrations that individually cover different items and that are based

⁴ We note, in that regard, that the application at issue herein originally recited goods in International Class 9, including "electric welding electrodes," in addition to the Class 7 goods identified above. Applicant deleted its identification of Class 9 goods in response to the examining attorney's first Office action.

on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

The examining attorney also introduced screen shots from the on-line retail websites of various suppliers of welding-related goods. This evidence shows that these retailers offer retail services through which consumers may purchase the goods of both applicant and registrant, and that the goods are offered under the respective marks mentioned.

We find that the examining attorney's evidence establishes that there is a viable relationship between applicant's goods and those of registrant. The evidence suggests that consumers have been exposed at least to welding machines as well as to welding wire electrodes, emanating from the same source under the same mark. Further, inasmuch as the identification of goods in both the involved application and cited registration are not limited to any specific channels of trade, we presume an overlap and that the goods would be offered in all ordinary trade channels for these goods and to all normal classes of

purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Applicant further argues that the classification of its goods in International Class 7, as opposed to registrant's goods which are classified in International Class 9, illustrates the differences between them. However, and as noted by the examining attorney, the classification of goods and services by the U.S. Patent and Trademark Office is a purely administrative determination and has no bearing on the issue of likelihood of confusion. See *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); and *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212 (TTAB 1990). (The classification system was established for the convenience of the Office rather than to indicate that goods in the same class are necessarily related or that classification in different classes indicates that they are not related). Thus, the classification of applicant's goods in International Class 9 and those of registrant in International Class 7 does not serve as evidence that the goods are somehow unrelated.

Applicant argues in addition that because of its prior Registration No. 1071690 for the mark XUPER for "metallic welding electrodes," the registration cited herein should

be afforded a narrow scope of protection. First, we note that the mark in applicant's Registration No. 1071099, namely, XUPER, is less similar both to the mark, SUPERARC, in the cited registration and the mark, XUPERARC in the application at issue. Second, it is well settled that each case must be decided on its own merits. Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the Office or the Board. See *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); and *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984).

In light of the foregoing, we conclude that consumers familiar with registrant's goods sold under its above-referenced mark would be likely to believe, upon encountering applicant's goods rendered under its mark that the goods originated with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Ser No. 78350479

Decision: The refusal to register is affirmed.